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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HYLINSKI, ALYSSA MARIE	
			ART UNIT 3711	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## Office Action Summary

Application No.

10/698,930

Applicant(s)

IACONIS ET AL.

Examiner

Alyssa M. Hylinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-37 and 39-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-20, 22-37, 39, 41-48 is/are rejected.
- 7) ☒ Claim(s) 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/8/07</u> <i>AMH</i>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/29/07 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 39, 41-43 and 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (3199248). Suzuki discloses a toy having a body with a driving device or motor (2) therein (Fig. 3). The driving device drives a drive shaft (3) with a rotating device attached thereto in the form of a crank having an eccentric rod as compared to the shaft (Figs. 2 & 3) that rotates as the drive shaft rotates. An appendage (9) has a first end connected to the rotating device via a connector piece (5) to allow the appendage to rotate relative to the body about a first axis that is parallel with the axis of the drive shaft in response to rotation of the device and oscillation of the connector piece (column 2 lines 55-62). A tail device has a connector piece (6) that

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interfits with a portion of the rotating device (Fig. 3) such that the tail device is rotated relative to the body about a second axis that is perpendicular to the first in response to rotation of the rotating device (column 2 lines 62-66). The connector piece connects to a lower piece of the tail device (11) such that the tail device oscillates about the second axis due to oscillation of the rotating device creating the appearance of a wagging tail (Fig. 3). The rotation of the appendage and tail device occurs simultaneously (column 3 lines 23-26).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7-18 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hornsby (6672934) and Suzuki. Hornsby discloses a toy having a body (12) that at least partly contacts a horizontal surface by means of legs (18,20), a motor or driving device (66) within the body (Fig. 11), an appendage (44) coupled to the body of the toy by means of the head (Fig. 8) that can be actuated by a motor to move relative to the body along a first path that includes movement of an end of the appendage along a non-circular path (Figs. 9a & 9b) such that movement of the appendage does not advance the body along the horizontal support surface, a tail device coupled to the body of the toy (16) and actuated by a motor to move relative to the body along a second path (Fig. 11) and a neck device (50) coupled to the body of

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the toy and actuated by the motor to move relative to the body along a third path (Fig. 11). The motor is coupled to the appendage by a cam or rotating device (86) having an eccentric rod (82) to which the appendage connects extends from the cam (Fig. 12) thereby forming a linkage rod (86) that is operably coupled to the body of the toy and fits within a slot of the appendage (Fig. 12) such that rotation of the cam causes the appendage to move along the first path (column 5 lines 6-11). The motor is coupled to a neck device (50) with a head attached thereto and includes a hinge (36) attached to the body such that the neck device is configured to rotate about the hinge as the neck device moves along the third path (Figs. 11 & 12). A drive shaft attached to the motor has a cam (90) on one end thereof and includes a connector piece (76) that connects to a lower piece of the tail device and couples to the cam such that rotation of the cam oscillates the connector piece and causes the tail to oscillate about a tail axis giving the appearance of a wagging tail (Fig. 16). The toy has a controller (64) located within the body and coupled to the motor (Fig. 10) and a sensor (34) connected to send a signal to the controller, which operates the motor in response to a signal from the sensor (column 4 lines 26-48). Another appendage shaped like the appendage is coupled to the body of the toy and positioned such that the ends of the appendages move in non-circular paths that are aligned with each other (Fig. 7). The toy also includes appendages at a portion of the body near the tail device that can remain stationary (Fig. 1). The device of Hornsby discloses the basic inventive concept, substantially as claimed, with the exception of a single motor operating a cam used for rotation of the appendage also receiving a drive shaft that also connects to the cam for the tail device and a follower

that attaches to the neck device such that movement of the follower in a periodic pattern causes the neck device to move along a third path. Suzuki discloses a toy animal device that has appendages, a tail and a neck that move simultaneously with respect to one another (column 3 lines 23-26). The tail, neck and appendage are all coupled to the body of the toy (Fig. 3) and are actuated by a motor (2) to move about their respective paths (Fig. 3). A drive shaft in the form of a crankshaft (4) couples the motor to a plurality of the moveable elements (Fig. 2) and includes a follower (15) that attaches to the neck and is moved in a periodic pattern to cause the neck device to move along a path (Fig. 2). It would have been obvious to one of ordinary skill in the art from the teaching of Suzuki to modify the device of Hornsby to include a single motor with a drive shaft that connects various moveable elements to the motor so as to reduce the number of parts needed and to include a follower so as to help get the movement of the motor to the neck region. Hornsby discloses a cam with a shaft that engages with a groove in the connector piece (Fig. 16) as opposed to the cam having a groove for receiving the shaft of the connector piece. The examiner notes that it would have been obvious to one of ordinary skill in the art to modify which piece contained the groove and which piece had the shaft since such a modification would have involved a mere rearrangement of parts. *See in re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hornsby and Suzuki and further in view of DeCesare (5876273). The device of Hornsby and Suzuki discloses the basic inventive concept substantially as claimed with the exception of a pivot gear coupled to the body of the toy and including a post that couples to a slot

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within the appendage, where gear teeth that mesh with gear teeth of the pivot gear extend from the cam such that rotation of the cam causes rotation of the pivot gear, which causes the appendage to move along the first path. DeCesare discloses a pivot gear (21) that includes a post for engaging a slot in an appendage and a cam or gear (22) engages the teeth the pivot gear (22) to cause the appendage to move along a first path (Fig. 2). The device of Hornsby and Suzuki uses an extending rod on a cam to fit in the slot of an appendage. It would have been obvious to one of ordinary skill in the art to use the system as shown by DeCesare so as to be able to obtain different movement effects.

7. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hornsby and Suzuki. The references disclose the basic inventive concept, substantially as claimed, with the exception of having another moveable appendage shaped like the other moveable appendage aligned with each other. The examiner notes that it would have been obvious to one of ordinary skill in the art to align multiple moveable appendages since such a limitation involves a mere duplication of parts; it has been held that a duplication of parts has no patentable significance unless a new and unexpected result is produced. *See in re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

8. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hornsby and Price (1782477). Hornsby discloses the basic inventive concept, substantially as claimed with the exception of a flexible skin or pile type material surrounding the body and appendages of the toy. Price discloses a moveable toy

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having fur or flexible material covering the entire toy (page 4 lines 16-20). It would have been obvious to one of ordinary skill in the art from the teaching of Price to cover the toy with the flexible material so as to give a more natural appearance to the toy (page 4 lines 16-20).

9. Claims 25-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pin-Hung (4878875) and Suzuki (3199248). Pin-Hung discloses a toy having a body (Fig. 3), a motor or driving device (11) within the body (Fig. 4), an appendage (8) coupled to the body of the toy (Fig. 3) is actuated by the motor to move relative to the body along a first path (column 2 lines 10-25) that including movement of an end of the appendage along a non-circular path (column 4 lines 9-12) and a neck device (34) coupled to the body of the toy and actuated by the motor to move relative to the body along a third path (column 3 lines 2-8). A drive shaft operatively couples the motor to the appendage (Fig. 4). The appendage has a first end (81) coupled to the body and actuated by the motor to rotate at the first end relative to the body about a first axis such that rotation of the first end causes the movement of the second end (91) to move along a non-circular path (column 3 line 64 –column 4 line 32). A cam or rotating device (31) receives the drive shaft such that rotation of the drive shaft rotates the cam (Fig. 4). An eccentric rod (82) to which the appendage connects extends from the cam (Fig. 6). A linkage rod (86) is coupled to the body of the toy and to a slot within the appendage and rotation of the cam causes the appendage to move along the first path (Fig. 6). The drive shaft further couples the motor to a neck device (Fig. 4). A head is connected to the neck device (Fig. 11), which includes a hinge (36) attached to the body such that the



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neck device is configured to rotate about the hinge as the neck device moves along the third path (Fig. 11). A follower (32) is attached to the neck device (Fig. 4) and coupled to the drive shaft by a cam (24) such that rotation of the drive shaft moves the follower in a periodic pattern and causes the neck device to move along the third path (column 3 lines 4-8). Another appendage shaped like the appendage is coupled to the body of the toy and positioned such that the ends of the appendages move in non-circular paths that are aligned with each other (Fig. 7). The toy also has a flexible skin cover (4) that resembles an animal's coat and surrounds the body and appendages of the toy (Fig. 1). The cover is attached or connected to a part of the second end of the appendage by means of its surrounding the appendage. The flexible skin is capable of being periodically tensioned and slackened as the second end of the appendage moves within it. The appendage is further actuated by the motor to rotate relative to the body about a first axis which runs horizontally through pin (96) and the neck device is further actuated by the motor to rotate relative to the body about a third axis that runs horizontally through hinge (36) making it parallel with the first axis. The device of Pin-Hung discloses the basic inventive concept, substantially as claimed with the exception of a moveable tail device. Suzuki discloses a toy animal device with appendages and a tail that move simultaneously with respect to one another (column 3 lines 23-26). The tail device (11) is coupled to the body of the toy (Fig. 3) and is actuated by a motor (2) to move relative to the body along a second path (Fig. 8). A drive shaft in the form of a crankshaft (3) couples the motor to the tail device (Fig. 3) and a connector piece (6) connects to a lower piece of a tail device to cause the tail to oscillate giving the

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appearance of a wagging tail (Fig. 3). It would have been obvious to one of ordinary skill in the art from the teaching of Suzuki to modify the device of Pin-Hung to include an oscillating tail in order to have a plurality of mechanisms moving in a timed relation so as to give an interesting and entertaining lifelike animation to the figure (column 3 lines 19-25). Regarding the limitation of a cam located on the drive shaft with a groove receiving the shaft of the connector piece, Pin-Hung discloses using cams on drive shafts having grooves formed between the lip of the pin on the cam and the cam itself that engage parts of the device such that rotation of the cam causes movement of the part (Fig. 6). The combination of Pin-Hung and Suzuki discloses a toy and a method of actuating a toy where the appendage and neck are actuated by a motor and rotated about a first and third axis, respectively, that are parallel to one another and a tail device coupled to the body of the toy and actuated by the motor is rotated relative to the body about a second axis that is perpendicular with the first axis (Fig. 2).

10. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki. Suzuki discloses the basic inventive concept, substantially as claimed with the exception of the rotating device defining a groove for receiving a shaft of the connector piece. Suzuki discloses a shaft shaped rotating device that engages with a groove in the connector piece (Fig. 16) as opposed to the rotating device having a groove for receiving the shaft of the connector piece. The examiner notes that it would have been obvious to one of ordinary skill in the art to modify which piece contained the groove and which piece had the shaft since such a modification would have involved a mere rearrangement of parts. *See in re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).*

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11. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (3443338) and Iwaya (3164924). Collins discloses a method of actuating a toy having a body (5) with an appendage, a tail and a neck coupled thereto (Fig. 1). The body at least partially contacts a horizontal surface (Fig. 1) and has a motor in the form of a solenoid (6) located within for actuating the appendage (11'), the tail device (Fig. 1) and the neck device (15). The appendage (11') is rotated relative to the body about a first axis by actuating the motor assembly without advancing the body along the horizontal support surface (column 1 lines 47-69). The neck device is rotated relative to the body about a third axis through a pivot point (15) that is parallel with the first axis (Fig. 1, column 1 lines 47-69). The tail device is also rotatable relative to the body upon actuation of the motor (column 2 lines 40-52). The device of Collins discloses the basic inventive concept, substantially as claimed, with the exception of disclosing how the tail moves relative to the body. Iwaya discloses a motorized toy with a plurality of moveable appendages including a tail (31) that moves relative to a body in a side to side motion (Fig. 4). It would have been obvious to one of ordinary skill in the art from the teaching of Iwaya to have the tail move from side to side so as to create a toy dog with realistic movement. The combination creates a device that allows the tail to move relative to the body about an axis that would be perpendicular to the first axis.

***Allowable Subject Matter***

12. Claim 40 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

13. Applicant's arguments with respect to claims 1-20, 22-37, 39,41-48 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hyllinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH

  
EUGENE KIM  
SUPERVISORY PATENT EXAMINER